IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: CHENEVICH et al.

Title: SYSTEM AND METHOD FOR STORING,
     CREATING, AND ORGANIZING FINANCIAL
     INFORMATION ELECTRONICALLY

Appl. No.: 10/799,378

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Examiner: Robert M. Timblin

Art Unit: 2167

Confirmation 7289
Number:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal. This communication is responsive to the Final Office Action dated December 7, 2007, concerning the above-referenced patent application, making April 7, 2008, four-months from the mailing date. Accordingly, this pre-appeal brief is timely filed with a one-month extension.

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow. Claims 1-14 are pending in this application.

I. Rejection of Claims 1-5, 7-8, and 10-14 Under 35 U.S.C. § 102(e)

On page 2 of the Office Action, Claim 1-5, 7-8, and 10-14 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0243494 to Jensen *et al.* (Jensen). Applicants respectfully traverse the rejection of Claims 1-5, 7-8, and 10-14 because Jensen fails to teach, suggest, or describe all of the elements as recited in at least independent Claims 1 and 10.

Independent Claim 1, with emphasis added through underlining, recites in part:

> providing an online environment by the second system configured to allow a customer user at the first system to create a folder in the online environment hosted at the second system, the folder being one of a plurality of folders associated with the first account; and to associate the financial document with the created folder so that the financial document is included in the created folder in the online environment hosted at the second system, wherein the online environment displays the financial document in the created folder

Independent Claim 10, with emphasis added through underlining, recites in part:

> an on-line environment for a customer user at a customer user computer connectable to the network to organize, send, search, create, and save financial information using a hierarchy of folders defined by the customer user in the online environment hosted at the host computer, wherein each folder in the hierarchy of folders includes a financial document that includes multiple indicators, wherein the host computer is configured to provide a search across folders

On pages 8-9 of the Office Action, with emphasis added through underlining, the Examiner states:

> Specifically, Jenson teaches "creating a folder in the online environment hosted at the second system" and "associating the financial document with the created folder so that the financial document is included in the created folder in the online environment hosted at the second system" as substantially seen in figures 13-14 and cited in the rejection to claim 1 above. That is, Jenson teaches a system where a hypothetical financial institution (0078 and figures 13-14; i.e. First online bank). Shown in figures 13-14, a web page of the institution is displayed so that a user may manage their account. For instance, the user may create a new folder name (i.e. creating a new folder named First Online Bank Cancelled Check images). As shown in figure 14, the folder First Online Bank Canceled Check Images contains records of checks (e.g. check #1014 and #1009). Therefore, by providing an online environment in which a user may create a folder and specify the documents to be contained in that folder (0023 describes specifying a folder in which to save contents). Furthermore, in the example of figures 13-14 of Jenson, the use of the financial institute's name (First Online Bank) clearly indicates that the web page presented is an online environment that is provided (or hosted) by the financial institute. Jenson also specifies that the shown web page is of the financial institute (paragraph 0079, line 5).

Applicants respectfully disagree. Jensen does not teach at least "providing an online environment by the second system configured to allow a customer user at the first system to create a folder in the online environment hosted at the second system" as recited by Claim 1 or "a hierarchy of folders defined by the customer user in the online environment hosted at the host computer" as recited by

Claim 10. Jensen describes use of an information capturing and indexing system executing at a user's computer which has browsing capability, but creates folders on the user's computer, using an application executing at the user's computer, and links to and downloads files to the user's computer, not in the online environment.

Jensen states that an "information capturing system and method is provided for retrieving financial transaction information and related images from a financial institution web site. .... The method further comprises specifying a folder in which to download the processed financial transaction document images; saving the processed financial transaction document images into the specified folder." (Abstract, with emphasis added through underlining). Jensen also states:

> The customers of these financial institutions, however, have no efficient way of making a permanent record and searchable archive of the cancelled check or deposit slip images. .... Needless to say, there is a substantial need for an efficient method of making a permanent and searchable database of a customer's check and deposit slip images.

(Para. [0006], with emphasis added through underlining). Jensen further states:

> Also provided is an information capturing system for retrieving financial transaction information. **The system comprises a browser module operable to link to a web page containing an account transaction history web page**, ..., and **automatically download the processed financial transaction document images without downloading the assortment of other objects**. The processed financial transaction documents may include cancelled checks.

(Para. [0022], with emphasis added through underlining and bolding). Thus, Jensen describes a system that allows customers to access and retrieve financial information from a web site and to download and save the financial information to the customer's computer creating a permanent record that the customer can maintain separate from the financial institution web site. Jensen further states:

> In functional block 1110, the user accesses account information on a financial institution web site. .... In functional block 1115, the user opens a web page listing his or her most recent financial transactions and providing links to images of financial transaction documents such as canceled checks, deposit slips, and the like. In functional block 1120, the user launches the **check image saving utility 250** of the information capturing and indexing system. In functional block 1125, the user specifies a folder in which to save the check images as well as the account information. A dialog box for specifying the folder is illustrated in FIG. 13, which is described in more detail below.
>
> In functional block 1130, the check image save utility 250 (FIG. 2) saves the viewed page to the folder specified in functional block

1125. In functional block 1135, the check image save utility 250 compiles a **list of links to images** of financial transaction documents such as canceled checks, deposit slips, and the like. In a preferred embodiment, **the check image save utility 250 identifies these links using predetermined knowledge of how the financial institution identifies these links in its web pages**. In this preferred embodiment, the check image save utility 250 will typically be customized for a specific financial institution.

(Paras. [0079]-[0080], with emphasis added through underlining and bolding).

Thus, again, Jensen describes a system executing at a user's computer system wherein the user accesses check images using a browser and downloads the check images to the user's computer in a folder created on the user's computer system using a utility executing on the user's computer. If the folder creation were in the online environment, compilation of a list of links would not be necessary because the web site already has the list of links and understands how the links are identified. Therefore, Jensen does not teach, suggest, or describe either "providing an online environment by the second system configured to allow a customer user at the first system to create a folder in the online environment hosted at the second system" as recited in Claim 1 or "a hierarchy of folders defined by the customer user in the online environment hosted at the host computer" as recited in Claim 10. To the contrary, the creation of folders described by Jensen is done only at the customer's computer and not "in the online environment hosted at the second system."

An anticipation rejection cannot properly be maintained where the reference used in the rejection does not describe all of the recited claim elements. As a result, Applicants respectfully request withdrawal of the rejection of Claims 1 and 10. The remaining claims depend from one of Claims 1 and 10. Therefore, Applicants also respectfully request withdrawal of the rejection of Claims 2-5, 7-8, and 11-14.

II.   Rejection of Claim 6 Under 35 U.S.C. § 103(a)

On page 6 of the Office Action, Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Jensen in view of U.S. Patent No. 5,842,185 to Chancey et al. (Chancey). Applicants respectfully traverse this rejection because the Examiner has failed to demonstrate that Jensen and Chancey, alone or in combination, teach, suggest, or describe all of the claim elements as recited in Claim 6. As discussed in Section I., Jensen fails to teach all of the elements of Claim 1 from which Claim 6 depends.

Chancey states that a "financial statement incorporating the transactions is provided in an electronic form understood by the computer, such as a computer data file, for updating the financial account." (Abstract). Chancey provides no teaching whatsoever for how documents are organized.

Chancey is directed to categorizing transactions contained within a single document. Thus, Chancey fails to teach, suggest, or describe at least "providing an online environment by the second system configured to allow a customer user at the first system to create a folder in the online environment hosted at the second system" as recited in Claim 1. Therefore, Jensen and Chancey fail to teach, suggest, or describe all of the claim elements as recited in Claim 1. An obviousness rejection cannot be properly maintained where the references used in the rejection do not describe all of the recited claim elements. Therefore, Applicants respectfully request withdrawal of the rejection of Claim 6, which depends from Claim 1.

III.   Rejection of Claim 9 Under 35 U.S.C. § 103(a)

On page 7, Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Jensen in view of U.S. Patent No. 6,950,943 to Bacha *et al.* (Bacha). Applicants respectfully traverse the rejection of Claim 9 because the Examiner has failed to demonstrate that Jensen and Bacha, alone or in combination, teach, suggest, or describe all of the claim elements as recited in Claim 9. As discussed in Section I., Jensen fails to teach all of the elements of Claim 1 from which Claim 9 depends.
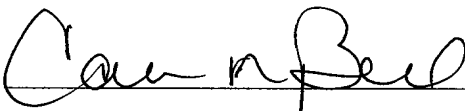
Bacha teaches that "[w]hen an electronic document is made available for review by other entities, it is often convenient to store the document in a repository or database managed by a third party." (Abstract). Thus, Bacha fails to teach, suggest, or describe at least "providing an online environment by the second system configured to allow a customer user at the first system to create a folder in the online environment hosted at the second system" as recited by Claim 1. Therefore, Jensen and Bacha fail to teach, suggest, or describe all of the claim elements as recited in Claim 1. An obviousness rejection cannot be properly maintained where the references used in the rejection do not describe all of the recited claim elements. Therefore, Applicants respectfully request withdrawal of the rejection of Claim 9, which depends from Claim 1.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

Date <u>April 2, 2008</u>

By _____

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